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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHIANG, JACK

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 08/06/2003

31

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/192303

Applicant(s)

M. Deguchi

Examiner

J. Chiang

Group Art Unit

2642

# 31

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 05-30-03.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 24-30, 36-40, 42-43, 45-50 is/are pending in the application.
- Of the above claim(s) 36-40, 42, 47 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 24-30, 43, 45-46, 48-50 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**RESTRICTION**

1. This application contains claims 36-40, 42, 47 drawn to an invention nonelected without traverse, see comments in Office action dated on 03-03-03. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**CLAIMS**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24-30, 45-46, 43, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (US 6519480) in view of Sudo et al. (US 5987336).

Regarding claim 24, Wicks shows:

Displaying, in a first user interface (display 15) on a housing (11) having a second user interface (17) on the same side as the first interface (15), a menu having items (see 16) and a highlight bar (col. 3, lines 22-24);

Moving four-way movement of a highlight bar (14, col. 3, lines 45-55);

Executing the selected item (14, col. 3, lines 62-66);

The moving and executing is performed without substantially repositioning the user's finger (col. 3, lines 66-67).

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Wicks differs from the claimed invention in that it does not explicitly show items in the menu representing a communication address.

However, Sudo teaches providing a phone menu having communication addresses (figs. 21-26).

Hence, it is commonly seen that today's phones having communication addresses stored in a menu. Therefore, if it is found that Wicks does not have an address menu, then it would have been obvious for one skilled in the art to modify Wicks with an address menu with/without the teaching of Sudo, because it is a conventional feature in today's phones, and it also functions as a notebook, in which it allows the user to store a plurality of data including phone numbers and names. It also allows the user to access the addresses as taught by Sudo and yet keeping the device in small size (col. 2, lines 39-53 in Sudo).

Regarding claim 43, Wicks shows a method for selecting one of the items displayed in rows and columns comprising:

Moving a highlight bar (col. 3, lines 45-55) in four directions by a movement key (14);

Only items on the columns is allowed to be scrolled (i.e. moving up and down on 16);

Executing the highlighted portion by an execution key (14, col. 3, lines 62-66);

The moving and executing is performed without substantially repositioning the user's finger (col. 3, lines 66-67).

Wicks differs from the claimed invention in that it does not explicitly show items in the menu representing a communication address.

However, Sudo teaches providing a phone menu having communication addresses (figs. 21-26).

Hence, it is commonly seen that today's phones having communication addresses stored in a menu. Therefore, if it is found that Wicks does not have an address menu, then it would have been obvious for one skilled in the art to modify Wicks with an address menu with/without the teaching of Sudo, because it is a conventional feature in today's phones, and it also functions as a notebook, in which it allows the user to store a plurality of data including phone numbers and names. It also allows the user to access the addresses as taught by Sudo and yet keeping the device in small size (col. 2, lines 39-53 in Sudo).

Regarding claims 25-30, 45-46, 48-50, the combination of Wicks and Sudo shows:

Scrolling the highlight bar, the memory, and items on the display (col. 3, lines 45-55, col. 4, lines 4-5 in Wicks; figs. 19-26 in Sudo);

Reading and arranging the data (col. 4, lines 4-5 in Wicks; fig. 26 in Sudo);

Selecting and executing a communication address (col. 3, lines 56-61, col. 4, lines 4-11 in Wicks; fig. 19 in Sudo);

The executing and communicating with another device (col. 4, lines 4-11 in Wicks; fig. 19 in Sudo);

The first user interface is a display (15 in Wicks), and the second user interface transmits sound waves (17 in Wicks);

The moving and executing is performed without removing the body part from the input device or key (14, col. 3, lines 66-67 in Wicks);

A plurality of keys (5 in Sudo).

### **ARGUMENT**

4. In response to the remarks (pages 4-6) filed on 05-30-03, applicant mainly argues that Wicks does not disclose a plurality of items, where each item represents a communication address. The examiner can agree with applicant. However, this feature is a well known feature in today's phones, and Sudo is cited to support the examiner's position. See rejections above.

5. Applicant's arguments with respect to claims 24-30, 43, 45-46, 48-50 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

  
Jack Chiang  
Primary Examiner  
Art Unit 2642